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Remarks:

Reconsideration of the application is requested.

Claims 1 to 40 remain in the application. Claims 1 to 24 and 33 to 40 are subject to examination and claims 25 to 32 have been withdrawn from examination. Claims 15 to 24 and 33 to 40 are allowed over the prior art. Claims 5 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In item 3 on pages 2 to 3 of the above-identified Office action, claims 1 to 4, 6 to 11, 13 and 14 been rejected as being fully anticipated by U.S. 5,049,153 to Nakao et al. (hereinafter "Nakao") under 35 U.S.C. § 102.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 calls for, *inter alia*, a surgical clip applier, including:

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- a) a hollow member having a proximal end and a distal end;
- b) a clevis coupled to a distal end of a hollow member;
- c) a first jaw rotatably coupled to the clevis;
- d) a second jaw rotatably coupled to the clevis in opposed relation to the first jaw, the first and second jaws having a respective longitudinal extent, at least one of said first and second jaws defining a channel extending substantially along said longitudinal extent and being shaped to guide a surgical clip, the first and second jaws adapted to slidably apply the surgical clip with the channel.

Claim 10 calls for, *inter alia*, a surgical clip applier, including:

- a) a hollow member having a proximal end and a distal end;
- b) a clevis coupled to the distal end of the hollow member;
- c) a first jaw rotatably coupled to the clevis, the first jaw having a longitudinal extent and a first clip guiding channel disposed substantially along said longitudinal extent and terminating in a first anvil;
- d) a second jaw rotatably coupled to the clevis in opposed relation to the first jaw, the second jaw having a longitudinal extent and a second clip guiding channel disposed substantially along said longitudinal extent and terminating in a second anvil, the first and second jaws adapted to slidably apply a surgical clip with said first and second clip guiding channels.

In the rejection, the Examiner has applied only the Nakao configuration shown in FIGS. 16 to 19 and as described at col. 9, line 53, to col. 10, line 60. These figures and the corresponding specification clearly provide that the two jaws "158 and 160 are formed on inwardly facing surfaces with

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respective longitudinal grooves 166 and 168 **in which** legs 170 and 172 of a staple 174 are seated." Nakao at col. 10, lines 13 to 15 (emphasis added). See also *id.* at line 21 ("seating in grooves 166 and 168.").

In order to keep the staple 174 within the jaws 158, 160 of the Nakao device, the staple 174 must be stationary, i.e., "seated." For, if the staple 174 moved in the grooves 166, 168, then it would have the chance of falling out of the interior chamber of the jaws 158, 160. As can be clearly seen in FIGS. 16 to 18, the top leg 170 of the staple 174 extends completely from the inner left-most end of the mouth of the jaws to the inner right-most end of the mouth of the jaws (at the curve defined by the Examiner in the rejection on page 3 as the "hook shaped anvil"). Such position holds the staple 174 in the jaws 158, 160 for use and Nakao does not suggest anything other than snugly seating the staple 174 in the jaws 158, 160. Accordingly, the staple 174 cannot slide in any way with respect to the jaws 158, 160 and **remains longitudinally fixed** with respect to the jaws 158, 160.

In complete contrast, claims 1 and 10 provide that the jaws of the invention of the instant application must "slidably apply" the surgical clip. Because the Nakao device cannot "slidably apply" the surgical clip, e.g., the staple 174, Nakao cannot

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be said to anticipate the invention as set forth in claims 1 or 10 of the instant application.

Based upon the above, claims 1 and 10 are believed to be allowable. Insofar as claims 2 to 9 and 11 to 14 are ultimately dependent upon claims 1 or 10, it is respectfully believed that these claims are allowable as well. Thus, the objection of claims 5 and 12 is believed to be moot.

In view of the foregoing, reconsideration and allowance of claims 1 to 24 and 33 to 40 are solicited.

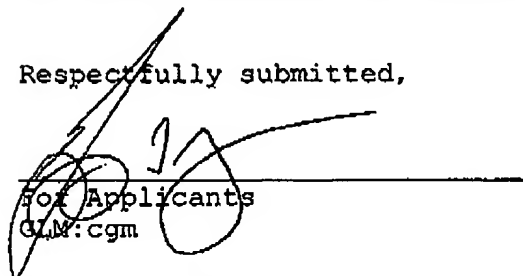
In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge the extension fee for response within a period of one (1) month in the amount of \$60.00 and any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Gregory L. Mayback, P.A., No. 503,836.

Respectfully submitted,


For Applicants
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April 20, 2006

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